



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Se

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,689	10/11/2001	Niko Canner	056732/00004	9226

31013 7590 04/29/2005

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

GYORFI, THOMAS A

ART UNIT PAPER NUMBER

2135

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,689

Applicant(s)

CANNER ET AL.

Examiner

Tom Gyorf

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 5-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3, and 5-33 remain for examination. The correspondence filed 11/15/04 amended claims 1, 3, 5, 9, 18-20, 22, 23, 28 and 30; added claims 31-33; and canceled claims 2 and 4.

Response to Arguments

2. Applicant's arguments filed 11/15/04 have been fully considered but they are not persuasive. Applicant argues, "*Sheehan does not teach delivery of specific advice as to what specific actions a testee or a group of testees should take to solve a particular problem or accomplish a given performance goal. In Sheehan, the results of the analysis are simply a categorization of scores in various groups based upon the number of correct answers submitted and on correlations between them.*" In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies to distinguish between the prior art and the instant application are not actually recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). To further address Applicant's argument, Sheehan discloses the ability to generate individualized feedback items (illustrated in Figure 6) based on established psychological theories (see col. 2, lines 1-60; col. 6, lines 20-45; col. 7, lines 50-67; col. 8, lines 35-50; etc.) which can be consulted to seek information as to the strengths and weaknesses of the evaluatee as to one or more identified performance areas (again see Figure 6, and also col. 15, lines 56-62), in accordance with Applicant's amended claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, and 5-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan (U.S. Patent 6,144,838).

Referring to Claims 1, 9, 22, 28 and 30:

Sheehan discloses a method of conducting an assessment of an evaluatee, comprising:

presenting a plurality of queries regarding an evaluatee to an entity (col 5, lines 45-55);

receiving a response to each of the plurality of queries (col 5, line 60-col 6, line 10);

applying the responses to a plurality of rules so that each rule has one of a satisfied state and an unsatisfied state, a portion of the plurality of rules being interdependent (col 5, lines 35-45; col 6, lines 30-45; col 7, lines 5-40);

generating theory-based individualized feedback items based on the state of the plurality of rules, each feedback item being associated with at least one of the plurality of rules having the satisfied state (col 9, lines 45-60; col 24, lines 5-55);

transmitting the feedback items to an entity (col 23, lines 30-45; Fig. 6),

wherein the plurality of queries seek information as to the strengths and weaknesses of the evaluatee as to one or more identified performance areas (col. 8, lines 56-62; Fig. 6).

Sheehan is apparently silent regarding specifically to whom the results generated by the disclosed method are transmitted. However, Sheehan does disclose that preferred embodiments of this invention include analyzing results for the SAT and the GRE (col. 8, lines 35-50; see also cols. 19 and 20), both of which are well known to return results to an evaluatee. Furthermore, Sheehan also suggests that in the general case it is advantageous to return individualized results to an evaluatee, in order to allow one to plan for enrollment in future courses as one example (col. 1, lines 45-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the feedback items to the evaluatee, so that the evaluatee can react appropriately to, and benefit from, the diagnosis (col. 1, lines 42-48).

Referring to Claim 3:

Sheehan discloses the limitation of Claim 1 above. Sheehan further discloses the entity is a group one or more persons (col 5, lines 30-35).

Referring to Claim 5:

Sheehan discloses the limitation of Claim 1 above. Sheehan further discloses a host computer presents the plurality of queries and transmits the feedback items to the evaluatee (col 23, lines 30-45).

Referring to Claim 6:

Sheehan discloses the limitation of Claim 1 above. Sheehan further discloses the plurality of rules include mathematical formulae (col 25, lines 5-30).

Referring to Claim 7:

Sheehan discloses the limitation of Claim 1 above. Sheehan further discloses the plurality of rules include Boolean operations (col 26, lines 45-55).

Referring to Claim 8:

Sheehan discloses the limitation of Claim 7 above. Sheehan further discloses ones of the plurality of rules use output from other of the plurality of rules (col 28, lines 20-45).

Referring to Claim 10:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the memory includes a query database storing the plurality of queries (col 8, lines 30-50).

Referring to Claim 11:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the memory includes a rules database storing the plurality of rules (col 26, lines 55-65).

Referring to Claim 12:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the memory stores the responses to the plurality of queries (col 8, lines 30-50).

Referring to Claim 13:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the user computer includes a display to display the feedback items (col 14, line 65-col 15, line 30).

Referring to Claim 14:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the plurality of rules include a Boolean operation, a true condition of the Boolean operation corresponding to the satisfied state and a false condition of the Boolean operation corresponding to the unsatisfied state (col 20, lines 20-55).

Referring to Claim 15:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the communications link includes one of a dialup connection, a wireless network connection, a local area network, a wide area network, fiber optic connection and an Internet connection (col 24, lines 15-25).

Referring to Claim 16:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the memory includes computer executable code identifying an additional set of queries to be presented to the entity as a function of a predetermined response to at least one of the plurality of the plurality of queries (col 13, line 5-50).

Referring to Claim 17:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the queries include one of a statement and a question (Fig. 2A).

Referring to Claim 18:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the computer executable code transmitting the feedback items to the user computer includes links to additional resources related to a respective feedback item (col 13, lines 35-60).

Referring to Claim 19:

Sheehan discloses the limitation of Claim 18 above. Sheehan further discloses the links include one of a hyperlink or URL and an identification of one or more additional resources (col 13, lines 35-60).

Referring to Claim 20:

Sheehan discloses the limitation of Claim 19 above. Sheehan further discloses hyperlink includes identification of a universal resource locator and the additional resource includes publication (col 13, lines 35-60).

Referring to Claim 21:

Sheehan discloses the limitation of Claim 9 above. Sheehan further discloses the entity includes one of an individual and a group (col 5, lines 30-40).

Referring to Claim 23:

Sheehan discloses a method of conducting an assessment of an evaluatee, comprising:

presenting a plurality of queries to an entity regarding an evaluatee (col 5, lines 45-55);

receiving a response to each of the plurality of queries (col 5, line 60-col 6, line 10);

applying the responses to a plurality of rules so that each rule has one of a satisfied state and an unsatisfied state, a portion of the plurality of rules being interdependent (col 5, lines 35-45; col 6, lines 30-45; col 7, lines 5-40);

generating theory-based individualized feedback items based on the state of the plurality of rules, each feedback item being associated with at least one of the plurality of rules having the satisfied state (col 9, lines 45-60; col 24, lines 5-55);; and

transmitting the feedback items [to the evaluatee: see rejection of claim 1 for obviousness/motivation], at least one of the feedback items including a link to an additional resource associated with the feedback item, wherein the plurality of rules results in at least a first comparative indicator and at least a second comparative indicator, the first comparative indicator representing an ideal situation for the evaluatee, and the second comparative indicator representing a current situation for the evaluatee (col 23, lines 30-45; Fig. 6; col 13, lines 30-55).

Referring to Claim 24:

Sheehan discloses the limitation of Claim 23 above. Sheehan further discloses the first comparative indicator includes two comparative indicators used to determine the ideal situation and the second comparative indicator includes two comparative indicators used to determine the current situation (Fig. 6).

Referring to Claim 25:

Sheehan discloses the limitation of Claim 24 above. Sheehan further discloses the feedback items include at least one feedback item based on a comparison between the ideal situation and the current situation (Fig. 6).

Referring to Claim 26:

Sheehan discloses the limitation of Claim 24 above. Sheehan further discloses displaying a comparison of the ideal situation and the current situation (Fig. 6).

Referring to Claim 27:

Sheehan discloses the limitation of Claim 23 above. Sheehan further discloses the plurality of queries relate to one of an individual assessment and a group assessment (col 5, lines 30-60).

Referring to Claim 29:

Sheehan discloses the limitation of Claim 23 above. Sheehan further discloses a storage medium coupled to the CPU, the storage medium including at least one database and storing the plurality of queries, the plurality of rules and the feedback item (col 24, lines 15-30).

Referring to Claim 31:

Sheehan discloses the limitations of Claim 1 above. Sheehan further discloses wherein said theory-based individualized feedback reflects one or more management or group dynamics theories or schools of thought (col. 2, lines 1-60; col. 6, lines 20-45; col. 7, lines 50-67; col. 8, lines 35-50).

5. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan as applied to claim 1 above, and further in view of Nichols et al. (U.S. Patent 5,987,443).

Referring to Claim 32:

Sheehan discloses the limitations of Claim 1 above. Sheehan is silent regarding the limitation wherein the theory-based individualized feedback includes one or more links to tools that address diagnosed deficiencies. However, Nichols discloses this limitation (col. 28, lines 17-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include one or more links to auxiliary tools that address diagnosed deficiencies into the invention disclosed by Sheehan. The motivation for doing so would be to conveniently provide means for an evaluatee to take appropriate action regarding the results of one's evaluation, thus increasing the effectiveness of the feedback (Nichols, col. 28, lines 55-57).

Referring to Claim 33:

Sheehan in view of Nichols discloses or suggests the limitations of Claim 32. Nichols further discloses that the tools comprise a method of conducting an assessment of an evaluatee (col. 29, lines 1-9). It should be noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the tools found in Nichols in accordance with the method disclosed in Sheehan. The motivation would be that the Sheehan disclosure, as noted in the rejection of claim 1, is very well suited

for analyzing a student's work to identify problem areas and deliver focused feedback, which is a requirement for the tools disclosed by Nichols (col. 29, lines 4-6).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

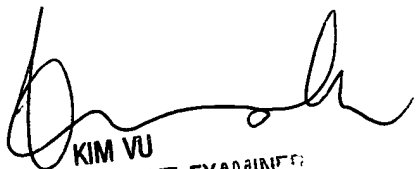
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG
4/21/05



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100